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CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: October 21, 2005 Name: John C. Freeman, Esq. Signature: [Signature]

BRINKS
HOFER
GILSON
& LIONE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Robert M. Setbacken et al.

Appln. No.: 10/829,546

Filed: April 22, 2004

For: POSITIONAL ENCODER ASSEMBLY

Attorney Docket No: 8371/13

Examiner: Monbleau,
Davienne N.

Art Unit: 2878

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL

Sir:

Attached is/are:

- ☒ Information Disclosure Statement, PTO Form 1449, Twelve (12) References.
- ☒ Return Receipt Postcard

Fee calculation:

- ☒ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 C.F.R. § 1.136(a).
- ☐ A petition or processing fee in an amount of \$_____ under 37 C.F.R. § 1.17(_____).
- ☐ An additional filing fee has been calculated as shown below:

| | | | | | Small Entity | | | Not a Small Entity | |
|---|-------------------------------------|-------|------------------------------------|------------------|--------------|-----------|----|--------------------|-----------|
| | Claims Remaining After Amendment | | Highest No. Previously Paid For | Present Extra | Rate | Add'l Fee | or | Rate | Add'l Fee |
| Total | | Minus | | | x \$25= | | | x \$50= | |
| Indep. | | Minus | | | x 100= | | | x \$200= | |
| First Presentation of Multiple Dep. Claim | | | | | +\$180= | | | +\$360= | |
| | | | | | Total | \$ | | Total | \$ |

Fee payment:

- ☐ A check in the amount of \$_____ is enclosed.
- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$_____. A copy of this Transmittal is enclosed for this purpose.
- ☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925.

Respectfully submitted,

[Signature]
John C. Freeman, Esq. (Reg. No. 34,483)

October 21, 2005

Date



I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 21, 2005.

Name of Registered Representative:

John C. Freeman
John C. Freeman, Reg. No. 34,483

October 21, 2005
Date of Signature

PATENT CASE NO. 8371/13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application:)
)
Robert M. Setbacken et al.)
) Group Art Unit: 2878
Serial No.: 10/829,546)
) Examiner: Monbleau, Davienne N.
Filed: April 22, 2004)
)
For: POSITIONAL ENCODER)
ASSEMBLY)

INFORMATION DISCLOSURE STATEMENT

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In compliance with Applicants' duty of disclosure under 37 C.F.R. § 1.56 and in conformance with 37 C.F.R. §§ 1.97-1.98, Applicants hereby submit the following references for consideration by the Examiner. Copies of all of the cited references, except the cited U.S. Patents are enclosed herein. Furthermore, enclosed is a completed copy of Form PTO-1449. Note that copies of the cited U.S. Patents are not being supplied pursuant to the amendment of the rules presented in the U.S. Patent and Trademark Office Official Gazette Notice dated October 12,

2004.

I. DISCLOSURE

A. U.S. Patents

| <u>Patent No.</u> | <u>Inventor</u> | <u>Issue Date</u> |
|-------------------|-----------------|-------------------|
| 5,861,680 | Yamanaka | 01/19/99 |
| 6,093,584 | Fjelstad | 07/25/00 |
| 6,331,452 B1 | Gall | 12/18/01 |

B. Foreign Patent References

| <u>Reference No.</u> | <u>Country</u> | <u>Pub. Date</u> |
|----------------------|----------------|------------------|
| 0 238 418 A2 | EP | 09/23/87 |

C. Literature

1. Author unknown, "Optical Incremental Encoder Modules – HEDS-90XX/91XX/9200 series," published by Agilent Technologies, September, 2000, two pages.
2. Author unknown, "Quick Assembly Two and Three Channel Optical Encoders – HEDS-5500/5540 series," published by Agilent Technologies, September, 2000, two pages.
3. Author unknown, "Reflective Optical Surface Mount Encoders – Technical Data - HEDR-8000 series, HEDR-8100 series, HEDR-8010 series" published by Agilent Technologies, April 23, 2003, pp. 1-8.
4. Author unknown, "Agilent HEDR-542x Series Optical Encoder Assemblies – Application Note 1267," published by Agilent Technologies, December 5, 2001, pp.

1-4.

5. Author unknown, "RCML15 Low Profile Commutation Encoder," published by Renco Encoders via website <http://www.renco.com/106028.htm> available as of October 20, 2005, two pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003.
6. Author unknown, "RCML15 Schematic Drawing," published by Renco Encoders via website <http://www.renco.com/106028.htm> available as of October 20, 2005, one page. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003.
7. Author unknown, "Mounting Instruction for the RCML15 Encoders – Data Only," published by Renco Encoders via website <http://www.renco.com/106041.htm> available as of October 20, 2005, five pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003.
8. Author unknown, "Mounting Instruction for the RCML15 Encoders – Static Communication," published by Renco Encoders via website <http://www.renco.com/106043.htm> available as of October 20, 2005, five pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003.
9. Author unknown, "Mounting Instruction for the RCML15 Encoders – Dynamic Commutation," published by Renco Encoders via website <http://www.renco.com/106042.htm> available as of October 20, 2005, five pages. Note that it is believed that the encoder shown in this document was available to the

public prior to April 25, 2003.

10. Author unknown, "Mounting Surface Requirements for RCML15 Encoders," published by Renco Encoders via website <http://www.renco.com/106044.htm> available as of October 20, 2005, three pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003.
11. Author unknown, "Bonding and Debonding Instructions for the Modular Encoders," published by Renco Encoders via website <http://www.renco.com/106038.htm> available as of October 20, 2005, three pages.

III. CONCLUSION

It is believed that none of these references, alone or in combination, disclose or suggest the invention claimed. Note that the submission of the references should not be construed as an admission that any of the references qualify as prior art. It is Applicants' desire, however, to have these references available in the record for both the Examiner and the public to see. Applicants

therefore request that the Examiner review the entire disclosure of each reference and make the above-listed references of record.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J.C. Freeman', is written over a horizontal line.

John C. Freeman
Registration No. 34,483
Attorneys for Applicants

BRINKS HOFER
GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4200

Dated: October 21, 2005



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|---|--|------------------------|
| 1449 | SERIAL NO. 10/829,546 | CASE NO. 8371/13 |
| LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT | FILING DATE April 22, 2004 | GROUP ART UNIT 2878 |
| (use several sheets if necessary) | APPLICANT(S): ROBERT M. SETBACKEN et al. | |

REFERENCE DESIGNATION

U.S. PATENT DOCUMENTS

| EXAMINER INITIAL | | DOCUMENT NUMBER <small>Number-Kind Code (if known)</small> | DATE | NAME | CLASS/ SUBCLASS | FILING DATE |
|---------------------|----|--|----------|----------|--------------------|----------------|
| | A1 | 5,861,680 | 01/19/99 | Yamanaka | | |
| | A2 | 6,093,584 | 07/25/00 | Fjelstad | | |
| | A3 | 6,331,452 B1 | 12/18/01 | Gall | | |
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FOREIGN PATENT DOCUMENTS

| EXAMINER INITIAL | | DOCUMENT NUMBER <small>Number-Kind Code (if known)</small> | DATE | COUNTRY | CLASS/ SUBCLASS | TRANSLATION YES OR NO |
|---------------------|----|--|----------|---------|--------------------|--------------------------|
| | A4 | 0 238 418 A2 | 09/23/87 | EP | | No |
| | | | | | | |
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OTHER ART – NON PATENT LITERATURE DOCUMENTS

(Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date page(s), volume-issue number(s), publisher, city and/or country where published.

| EXAMINER INITIAL | | |
|---------------------|----|--|
| | A5 | Author unknown, "Optical Incremental Encoder Modules – HEDS-90XX/91XX/9200 series," published by Agilent Technologies, September, 2000, two pages. |
| | A6 | Author unknown, "Quick Assembly Two and Three Channel Optical Encoders – HEDS-5500/5540 series," published by Agilent Technologies, September, 2000, two pages. |
| | A7 | Author unknown, "Reflective Optical Surface Mount Encoders – Technical Data -HEDR-8000 series, HEDR-8100 series, HEDR-8010 series" published by Agilent Technologies, April 23, 2003, pp. 1-8. |
| | A8 | Author unknown, "Agilent HEDR-542x Series Optical Encoder Assemblies – Application Note 1267," published by Agilent Technologies, December 5, 2001, pp. 1-4. |
| | A9 | Author unknown, "RCML15 Low Profile Commutation Encoder," published by Renco Encoders via website http://www.renco.com/106028.htm available as of October 20, 2005, two pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003. |

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|----------|-----------------|
| EXAMINER | DATE CONSIDERED |
|----------|-----------------|

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

| | | |
|--|--|------------------------|
| FORM PTO-1449 | SERIAL NO. 10/829,546 | CASE NO. 8371/13 |
| LIST OF PATENTS AND PUBLICATIONS FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT | FILING DATE April 22, 2004 | GROUP ART UNIT 2878 |
| (use several sheets if necessary) | APPLICANT(S): ROBERT M. SETBACKEN et al. | |

| EXAMINER INITIAL | OTHER ART – NON PATENT LITERATURE DOCUMENTS (Include name of author, title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date page(s), volume-issue number(s), publisher, city and/or country where published. | |
|---------------------|---|--|
| | A10 | Author unknown, "RCML15 Schematic Drawing," published by Renco Encoders via website http://www.renco.com/106028.htm available as of October 20, 2005, one page. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003. |
| | A11 | Author unknown, "Mounting Instruction for the RCML15 Encoders – Data Only," published by Renco Encoders via website http://www.renco.com/106041.htm available as of October 20, 2005, five pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003. |
| | A12 | Author unknown, "Mounting Instruction for the RCML15 Encoders – Static Communication," published by Renco Encoders via website http://www.renco.com/106043.htm available as of October 20, 2005, five pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003. |
| | A13 | Author unknown, "Mounting Instruction for the RCML15 Encoders – Dynamic Commutation," published by Renco Encoders via website http://www.renco.com/106042.htm available as of October 20, 2005, five pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003. |
| | A14 | Author unknown, "Mounting Surface Requirements for RCML15 Encoders," published by Renco Encoders via website http://www.renco.com/106044.htm available as of October 20, 2005, three pages. Note that it is believed that the encoder shown in this document was available to the public prior to April 25, 2003. |
| | A15 | Author unknown, "Bonding and Debonding Instructions for the Modular Encoders," published by Renco Encoders via website http://www.renco.com/106038.htm available as of October 20, 2005, three pages. |

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